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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,128	12/24/2003	John C. Reed	66821-0058	1734
41552	7590	06/29/2007	EXAMINER	
MCDERMOTT, WILL & EMERY			AUDET, MAURY A	
4370 LA JOLLA VILLAGE DRIVE, SUITE 700			ART UNIT	PAPER NUMBER
SAN DIEGO, CA 92122			1654	
MAIL DATE		DELIVERY MODE		
06/29/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/748,128	REED ET AL.
Examiner	Art Unit	
Maury Audet	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 June 2006.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 69-87 is/are pending in the application.
  - 4a) Of the above claim(s) 83-87 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 69-82 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2/26/07 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/07</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's amendment and response of 2/26/07 is acknowledged. New claims 69- 87 are filed herein. Claims 83-87 remain withdrawn as to the non-elected method (appropriate claim identifier is required in response hereto). Claims 69-82 are examined on the merits as drawn to the elected TPI 927 compounds and complexes thereof (products). [Regarding the previous 35 USC 103 arguments, which are acknowledged, it is noted that Applicant's arguments were directed to the intended use of the elected products, arguments which may bear weight as to methods of use, but not products].

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 69-70 and 72-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Nefzi et al. (Tetrahedron Letters (2000), 41(29), 5441-5446).

As discussed in the previous action, Nefzi et al. teach an efficient two-step synthesis of mono-, di-, and triureas from resin-bound amides, which bear very close (if not express) limitations with the core structure options to that of elected TPI 927. See e.g. RN 295343-42-9 in the attached reference.

Art Unit: 1654

[The amended claims have now clarified the invention, and as stated in the previous 103 rejection, “If not intrinsic therein” and “[The applied reference has common inventors (Nefzi and Houghten) and with the instant application. However, based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(b); therefore the options under other sections of 102 are not deemed available.]” The Examiner now finds that Nefzi et al. does in fact expressly teach one or more compounds directed to TPI-927, as now claimed by amendment.

Claims 69-70 and 72-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Stebani et al. (J. of Materials Chemistry, (1997), 7(4), 607-614; abstract).

Stebani et al. teach one or more of the present TPI 927 compounds. See e.g. the absolute chemistry of compounds within the reference, in the attached copy of the reference.

#### ***Claim Rejections - 35 USC § 112 2nd***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of new claims 69-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In e.g. claims 69 and 75, the claims remain drawn to isolated agents comprising the core structures of TPI 927 (in e.g. Figure 9). However, there is no definition for what R1, R2, and R3 are? Claims 69 and 75 remain indefinite. It is suggested that claim 70 be incorporated into

claims 69 and 75, respectively. As stated before, "...Applicant is required to expressly claim the core formula of TPI 927 and expressly claim the different R1-R3 groups which may stem therefrom [ ]".

Claims 71 and 77 the claims are indefinite, based on the elected invention to TPI 927 compounds and reference to Figure 22A. Figure 22A is to TPI 1396? TPI 927 is in Figures 6A/B and 9? It is unclear what the latter has to do with the presently elected invention.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 06/23/2007



CHRISTOPHER R. TATE  
PRIMARY EXAMINER